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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/712,243 | 11/13/2003 | Gerald J. MacKey | 03-5371 | 8585 |
| 7590 | 11/02/2004 | | EXAMINER | |
| Edward M. Livingston 963 Trail Terrace Drive Naples, FL 34103 | | | CHAPMAN, JEANETTE E | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3635 | |

DATE MAILED: 11/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|-----------------|-------------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/712,243 | MACKEY ET AL. <i>SS</i> |
| Examiner | Art Unit | |
| Chapman E Jeanette | 3635 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 13 November 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-50 is/are pending in the application.
 - 4a) Of the above claim(s) 38-50 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-17 and 19-37 is/are rejected.
- 7) Claim(s) 18 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>11/13/2003</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input checked="" type="checkbox"/> Other: <u>www.surfacing solutions website page</u> |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-37, drawn to the modular coffer trim kit, classified in class 52, subclass 311.1.
- II. Claims 38, drawn to a method of installing a modular coffer trim kit, classified in class 52, subclass 741.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions Group I and Group II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the method could be applied with a trim kit having additional features over those claimed in the apparatus claims of group I.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr Livingston on 10/27/04 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-37. Affirmation of this election must be made by applicant in replying to this Office action. Claims 38-50 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7, 10-17 and 19-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Ritzer et al (6751916). A modular assembly 10 comprising:

- A coffer modules having a predetermined shape;
 - At least one side;
 - A lowered section adjacent reference number 12 attached the one side; the lowered section is secured to a surface using screws or the like, this includes a butterfly bolt;
 - Raised section adjacent reference number 30 attached to the lower side;
- The module side is attached to an inner trim 30;

- The inner trim includes one precut hole 12; the precut hole is circular but may be any shape, such as square or rectangular, deemed suitable to attach to a screw and provide a decorative appearance;
- The inner trim has a predetermined shape;
- The coffer module attached to the inner trim is directly securable to a surface; see claim 1;
- The modules may be constructed of wood, metal or plastic;
- Ornaments 50 are attached to the inner trim 30;
- The raised and lowered section of the modules are square/rectangular see figures 1 and 2; the configuration and relative sizes of the raised and lowered sections has been considered a matter of choice; One of ordinary skill in the art would have appreciated making them of any configuration commensurate with the intended design and function of the assembly. raised and lower;
- The tiles may be secured on a support surface such as a floor and wall but also including a ceiling;
- The bottom trim is considered the one shelf capable of being directly attached to a surface;
- Ritzer et al suggest a plurality of ornamental elements, see figure 6; the choice of any one is not viewed as significant; one of ordinary skill in the art would have appreciated employing any ornament commensurate with the theme of the decorative structure desired;

The grid of Ritzer has been considered as a coffer or sunken panel and as a kit as he discloses all of them together in a single unit and the grid has sunken panels.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 8, 37- are rejected under 35 U.S.C. 103(a) as being unpatentable over Ritzer et al in view of Eichhorn (6240685). Eichhorn discloses the outer trim 14/16 around a panel having inner trim. It would have been obvious to include this outer trim around the entirety of the decorative grid of Ritzer et al in order to give the same a finished appearance. Further, Ritzer et al already discloses the material of choice of wood, plastic or metal and hence it is obvious to not only include the outer trim but also to construct it of any material desired and in context with the intended purpose and design of the structure

Claims 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ritzer et al in view of Eichhorn (6240685) and Sharber et al (5513935). Ritzer lacks the outer trim and ornaments attached to the outer trim. Sharber discloses a decorative nail which is capable of being employed to secure the outer trim to the grid. It would have been obvious to one of ordinary skill in the art to modify Ritzer et al to not only provide

the outer frame but to secure it to the grid using the decorative nail of Sharber et al in order to keep with the decorative them of the structure of Ritzer el.

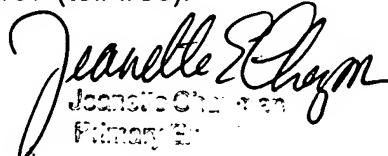
Allowable Subject Matter

Claims 18 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chapman E Jeanette whose telephone number is 703-308-1310. The examiner can normally be reached on Mon.-Fri, 8:30-6:00, every other fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Friedman Carl can be reached on 703-308-0839. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jeanette Chapman
Primary Examiner

Primary Examiner
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Primary Examiner